

## AMENDMENTS

### In the Claims:

Please cancel claim 13.

## REMARKS

### Rejection of Claims 12 and 13 Under 35 U.S.C. §251

Claims 12 and 13 stand rejected as being unpatentable under 35 U.S.C. §251.

In making this rejection, the Examiner contends that:

The original patent shows an intent not to claim the newly presented invention. Hence, the invention cannot be added by reissue.

There is no evidence in the specification that applicants ever considered claims 12 and 13 to be their invention. The summary of the invention and the detailed description of the invention in the patent recite that the invention relates to compounds of formula (I), compositions and use for the treatment of all anxiolytic disorders. The specification fails to recite that applicants ever considered the newly added compounds as their invention. Further, the specification is silent as to whether or not the newly added compounds treat any anxiolytic disorders.

(Office Action at page 2)

Applicants respectfully traverse. This rejection is a reiteration of the rejections made on March 12, 2000, July 11, 2000, January 25, 2001 and October 5, 2001 in the prosecution history of this reissue. The basis for rejection was addressed by Group Director Bruce M. Kislik in a the Petition Decision of May 3, 2002. The Director explicitly stated that the reissue declaration was suitable and the new claims have proper support:

The reissue declaration is sufficient in pointing out the error in not claiming certain "intermediate" (precursor) compounds which have proper support in the specification, as filed. No additional reissue declaration was or will be needed unless an amendment is made to the specification or claims.

(Emphasis in original, Petition Decision at page 2).

Cancellation of claim 13, which returns the specification and claims as they were at the time of this decision, renders the Examiner's rejection moot. The Decision indicated that the application "will be forwarded to the examiner for further prosecution not inconsistent with

this decision." (Petition Decision at p. 4.) Because of the Director's decision in the Petition Decision of May 3, 2002 has already decided the sufficiency of applicant's intent to claim, it is submitted that the rejection of claim 12 under 35 U.S.C. §251 should be withdrawn.

#### **Rejection of Claims 12 and 13 Under 35 U.S.C. §101**

Claims 12 and 13 stand rejected as being unpatentable under 35 U.S.C. §101.

In making this rejection, the Examiner contends that:

No evidence can be found in the specification that the instant compounds have any use at all. The Supreme Court declined to express a view as to whether patentability can be based on a product shown to inhibit the growth of tumors in laboratory animals. Brenner, Comr. Pats v. Manson, (USSC 1966) 383 US 519, 148 USPQ 689. The Court did state, however, that Congress did not intend that a patent be granted on a chemical compound, or a process for its production, whose sole "utility" consists of its potential role as an object of use-testing, reasoning the patent system is related to the world of commerce rather than the realm of philosophy *ibid.*, 148 USPQ at 696. ... (Office Action at page 3)

Applicants respectfully traverse.

The disclosure as a chemical intermediate at columns 3, 13-14 and 17 indicates that the compound of claim 12 is useful as a chemical intermediate in making the final product compounds of claims 1-8. Claim 13 has been cancelled. The disclosure at columns 3-4 indicates that the compounds of claims 1-8 are useful for the treatment of anxiolytic disorders among other central nervous system disorders and diseases.

Established precedent from the Patent Office's reviewing court dictates that chemical intermediates useful in making other useful compounds are themselves useful under §101.

In In re Joly 376 F.2d 906, 153 U.S.P.Q. 45 (C.C.P.A. 1967) and In re Kirk, 376 F.2d 936, 153 U.S.P.Q. 48 (C.C.P.A. 1967) the Court of Customs and Patent Appeals distinguished the Brenner decision cited by the examiner and upheld the decision in Reiners v. Mehlretter, 236 F.2d 418, 111 U.S.P.Q. 97 (C.C.P.A. 1956). In Reiners, the court held that compounds were useful where the compounds were employed as intermediates to produce other useful compounds. Reiners, 236 F.2d at 421-2 (C.C.P.A. 1956). In re Kirk and In re Joly distinguished Brenner by finding that Brenner only applied to compounds and intermediates to these compounds, when the compounds had merely conjectural utility or

utility that was demonstrated only through analogy to compounds of known usefulness. In re Kirk 376 F.2d at 945-6; In re Joly 376 F.2d at 908-9.

Because intermediates that produce other useful compounds are useful within the meaning of 35 U.S.C. §101, the compound of claim 12 is useful and patentable, and the rejection of claim 12 under 35 U.S.C. §101 should be withdrawn.

**Rejection of Claims 12 and 13 Under 35 U.S.C. §112**

Claims 12 and 13 stand rejected as being unpatentable under 35 U.S.C. §112.

In making this rejection, the Examiner contends that:

No enablement is shown for the treatment of all anxiolytic disorders. The tests set forth in column 4 of the specification are insufficient to support the compounds of claims 12 and 13 for the treatment of any and all anxiolytic disorders. The disclosure provides no indication of whether the compounds treat any disease. ... (Office Action at page 3)

Applicants respectfully traverse. Claim 13 has been cancelled. The disclosure at columns 3, 13-14 and 17 indicates how the compound of claim 12 is made and used to make the final product compounds of claims 1-8. It is unchallenged that claims 1-8 are enabled. Because the detailed experimental described in the specification at columns 13-14 enables one skilled in the chemical arts to make and use the compound of claim 12, it is submitted that the compound of claim 12 is enabled and patentable and that the rejection of claim 12 under 35 U.S.C. §112 should be withdrawn.

**Rejection of Claim 13 Under 35 U.S.C. §§112 and 251**

Claims 13 stands rejected as being unpatentable under 35 U.S.C. §§112 and 251. Because claim 13 has been cancelled, it is submitted that the rejections of claim 13 under 35 U.S.C. §§112 and 251 are moot and should be withdrawn.


CONCLUSION

It is submitted that the claims are now of proper form and scope for allowance and the applicants respectfully request that these rejections be withdrawn. An early and favorable action on the merits is respectfully requested. Should the examiner wish to discuss the foregoing, or any matter of form in an effort to advance this application toward allowance, the examiner is urged to telephone the undersigned at the indicated number.

Respectfully submitted,

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